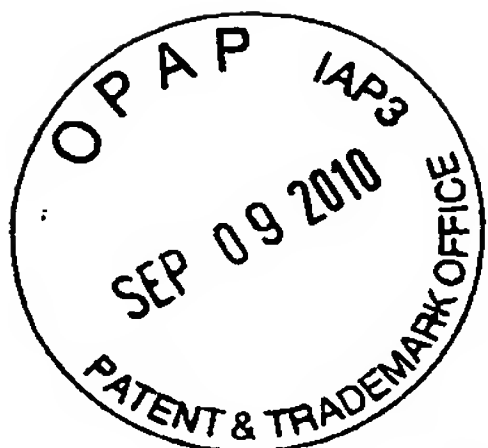


IFW



Atty. Dkt. No. 016906-0489

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Walter WOLF

Title: METHOD AND DEVICE FOR THE PRODUCTION OF A
COMPONENT, ESPECIALLY A HYBRID COMPONENT FOR A
CROSSRAIL OF A VEHICLE, COMPONENT AND USE OF SAID
COMPONENT

Appl. No.: 10/574,771

International Filing Date: 10/8/2004
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Examiner: Livius Radu Cazan

Art Unit: 3729

Confirmation Number: 2542

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the objection for a lack of unity of invention set forth in the Office Action mailed June 18, 2010, Applicant hereby elects Group III, Claims 26-39, for prosecution in the subject application, with traverse.

Applicant traverses the objection for a lack of unity of invention because the Office has not set forth a proper objection for a lack of unity. The Office indicates on page 2 of the Office Action that Group I is directed to a method of manufacture, Group II is drawn to an apparatus, Group III is directed to a component, and Group IV are drawn to methods of use. The Office argues on pages 2-3 of the Office Action that there is a lack of unity of invention between these groups because the method of Group I and products of Groups III and IV (even

though Group IV is directed to method claims) do not require the device of Group II and the device of Group II can be used to practice other methods.

37 C.F.R. § 1.475(b) states that a national stage application, such as this application, “containing claims to different categories of invention will be considered to have unity of if the claims are drawn only to one of the following combinations of categories:” and proceeds in 37 C.F.R. § 1.475(b)(3) to list a product, process specially adapted for the manufacture of the product, and use of the product as one of the categories.

As indicated by the Office, Group I is directed to a method of manufacture, Group III is directed to a product, and Group IV is directed to method of use. Further, Group I to directed to a method that is specially adapted for the manufacture of the product of Group III and the method of Group I would inherently produce the product of Group III. See MPEP §§ 1850 and 1893.03(d). Applicant notes that the claims of Group IV include the features of claim 1, which is included in the claims of Group I. As noted by the Office on pages 2-3 of the Office Action, Groups I, III, and IV “all have as a special technical feature the plastic provided on inner walls such that a cavity is formed between the plastic and the connection points of the base body.” In other words, Groups I, III, and IV share a common special technical feature.

For at least these reasons, the claims of Groups I, III, and IV have unity of invention and should not be separated into different groups because these claims are directed to a product (the claims of Group III), a process specially adapted for the manufacture of the product, and a use of the product. In other words, claims 1-18 and 26-44 should be grouped together.

The Office further argues on pages 2-3 of the Office Action that the claims of Groups I, III, and IV lack unity of invention because although Groups I, III, and IV “all have as a special technical feature the plastic provided on inner walls such that a cavity is formed between the plastic and the connection points of the base body,” there is a lack of unity of invention because “this structure is not deemed, *a priori*, novel, and groups I, III, and IV therefore lack a common or corresponding special technical feature” (emphasis added). The Office further states on page 3 of the Office Action that “[t]his assumption will be reevaluated at the time of the search, i.e. if no art is found which teaches this structure” (emphasis added).

This is not a proper objection for a lack of unity. First, as noted by the Office, the claims of Groups I, III, and IV share a common special technical feature, so there is no lack of unity for not sharing such a feature. Second, the Office has not demonstrated that the common special technical feature identified by the Office is known in the art. Instead, the Office asserts a lack of unity of invention by simply assuming that the common special technical feature is known in the art without providing any evidence in the art to support this assumption.

In addition, the Office notes on page 3 of the Office Action that this is an *a priori* objection for lack of unity. In other words, this objection has been made before a consideration of the claims in relation to any prior art. See MPEP § 1850, which states the following:

Lack of unity of invention may be directly evident "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. For example, independent claims to A + X, A + Y, X + Y can be said to lack unity *a priori* as there is no subject matter common to all claims. In the case of independent claims to A + X and A + Y, unity of invention is present *a priori* as A is common to both claims. However, if it can be established that A is known, there is lack of unity *a posteriori*, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.

As stated in MPEP § 1850, unity of invention exists *a priori* when there is a common subject matter, i.e. a common technical feature is present. The Office states on pages 2-3 of the Office Action that the claims of Groups I, III, and IV have a common special technical feature. Therefore, because the claims of Groups I, III, and IV have a common special technical feature, the Office has not set forth a prior *a priori* objection for lack of unity.

Nor has the Office demonstrated that this common special technical feature is known in the art because the Office has only assumed that this is true without providing any evidence that the common special technical feature is known in the art. As a result, the claims of Groups I, III, and IV should be in a single group and do not lack unity of invention.

For at least these reasons, Applicant respectfully requests examination of claims 1-18 and 26-44.

Applicant reserves the right to seek rejoinder of unexamined claims should the elected product claims be found allowable. See MPEP § 1893.03(d).

Applicants, of course, reserve the right to file a divisional application covering the non-elected subject matter. Receipt of an Office Action on the merits is awaited. If the Examiner has any questions, the Examiner may contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extension fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date September 9, 2010

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